

REMARKS

This responds to the Final Office Action mailed on April 1, 2008.

Claims 1 and 34-36 are pending in this application.

Applicants respectfully request reconsideration and withdrawal of the rejections in view of the remarks herein.

§102 Rejection of the Claims

BAB15511

The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as allegedly anticipated by accession no. BAB15511 (the BAB15511 reference). The Examiner alleged that even though the BAB15511 reference does not disclose that the protein is glycosylated, because it is found in human signet-ring cell carcinoma, it would be glycosylated. The Examiner also alleged that a disclosure of an amino acid sequence would indicate to one skilled in the art that the person who disclosed the sequence was in possession of the glycosylated protein. Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Claim 1 is not anticipated by the BAB15511 reference because each and every element of claim 1 is not expressly or inherently described in the BAB15511 reference.

Claim 1 is directed to an isolated protein that is glycosylated. The BAB15511 reference does not anticipate claim 1 because it does not expressly or inherently disclose an isolated protein of SEQ ID NO: 1 that is glycosylated.

The BAB15511 reference merely discloses an amino acid sequence obtained by translation of the cDNA sequence (AK026622.1) of clone KAT10759. Nowhere does the BAB15511 reference indicate that clone KAT10759 is capable of expressing a protein from the cDNA sequence, let alone express and glycosylate this protein. Although the BAB15511 reference indicates that the cloning vector used was pME18SFL3, the cDNA sequence may be inserted into the cloning vector in the incorrect orientation with respect to the promoter resulting

in no expression of the encoded protein. In other words, the cDNA coding sequence is not necessarily operably-linked to a promoter as would be required for protein expression, and the BAB15511 reference does not indicate that the cDNA insert is linked in such a manner. Thus, Watanabe et al. and Sugano et al., the contributors of the sequence disclosed in the BAB15511 reference, are not necessarily in possession of a protein encoded by the cDNA sequence, let alone one that is glycosylated as claimed. In other words, contrary to the Examiner's assertion, disclosure of an amino acid sequence does NOT indicate to one skilled in the art that the person who disclosed the sequence is in possession of the protein let alone one that is glycosylated.

The Examiner's allegation that even though the BAB15511 reference does not disclose that the protein is glycosylated, because it is found in human signet-ring cell carcinoma, it would be glycosylated, even if true, does not negate the patentability of claim 1. The BAB15511 reference does not indicate that Watanabe et al. isolated the claimed protein from signet-ring cell carcinoma. Moreover, the BAB15511 reference does not provide a reason to do so, nor does it provide a reason to expect that the protein would be glycosylated as claimed.

In sum, the BAB15511 reference does not anticipate claim 1 because the Examiner has failed to show that every element of the claimed invention is disclosed in the BAB15511 reference. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

Q9H5V8

The Examiner also rejected claim 1 under 35 U.S.C. § 102(b) as allegedly anticipated by accession no. Q9H5V8. The Examiner alleged that while Q9H5V8 does not disclose that the protein is glycosylated, the human protein as disclosed by accession no. Q9H5V8 would be inherently glycosylated. Applicants respectfully traverse this rejection.

Q9H5V8 provides no more than that disclosed by the BAB15511 reference. Lines 13-15, 16, and 6 of the Q9H5V8 reference indicate that Watanabe et al. submitted a sequence determined from a human cDNA sequencing project, in particular, clone KAT10759. Q9H5V8 specifically reference the BAB15511.1 entry and its corresponding cDNA sequence AK026622 at line 22. Thus, Q9H5V8 does not anticipate claim 1 for the same reasons discussed above for BAB15511.

Accordingly, Q9H5V8 does not anticipate claim 1, and Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6913 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

July 1/08

By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1st day of July, 2008.

CANDIS BUENDING

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